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|---|-------------|----------------------|-------------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 08/873,597 | 06/12/1997 | JON FAIZ KAYYEM | A-64558-1/RF | 2066 |
| 7590 | 03/15/2004 | | EXAMINER | |
| ROBIN M SILVA FLEHR HOHBACH TEST ALBRITTON & HERBERT FOUR EMBARCADERO CENTER SUITE 3400 SAN FRANCISCO, CA 941114187 | | | FORMAN, BETTY J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1634 | |
| | | | DATE MAILED: 03/15/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|------------------------|---------------------|--|
| Advisory Action | Application No. | Applicant(s) | |
| | 08/873,597 | KAYYEM, JON FAIZ | |
| Examiner | Art Unit | | |
| BJ Forman | 1634 | | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) The period for reply expires _____ months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on 01 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. The proposed amendment(s) will not be entered because:

(a) they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) they raise the issue of new matter (see Note below);
 (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, second paragraph & ODP.

4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Continuation of Advisory Action.

6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 19-22,26,33-35 and 39-45.

Claim(s) withdrawn from consideration: _____.

8. The drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. Other: _____


 BJ Forman
 Primary Examiner
 Art Unit: 1634

Continuation of Advisory Action

Status of the Claims

This action is in response to After Final papers filed 1 March 2004 2003 in which claims 23-25, 27-32 and 36-38 were canceled; a Terminal Disclaimer was submitted and Arguments regarding rejections in the Final Office Action were presented.

The amendments have been thoroughly reviewed and entered. The previous rejections in the Final Office Action dated 29 October 2003 under 35 U.S.C. 112, second paragraph are withdrawn in view of the amendments. The previous rejection under obviousness-type double patenting over 6,248,229 is withdrawn in view of the Terminal Disclaimer. The previous rejection under obviousness-type double patenting over 6,096,273 is withdrawn in view of Applicant's arguments. The previous rejections under 35 U.S.C. 102(e) are maintained.

All of the arguments have been thoroughly reviewed and are discussed below.

Claims 19-22 26, 33-35 and 39-45 are under prosecution.

Response to Arguments

Applicant argues that the Office has not pointed to a teaching in Kayyem wherein the nucleic acids are attached to the electrodes via insulators. The argument has been considered but is not found persuasive because, contrary to Applicant's assertion, the teaching of nucleic acids via insulators has been cited (page 4, second paragraph, line 5 i.e. Column 23, lines 21-65). In the cited passage, Kayyem teaches passivation agent layer between the electrode and nucleic acid (lines 35-54) wherein the passivation agent layer are "insulating molecules" (line 58). As such, Kayyem clearly teaches the claimed nucleic acid attached via an insulator.

Applicant cites the passage at Column 24, lines 59-61. Applicant appears to be arguing that "A" taught by Kayyem is not an insulator as claimed. However, as Applicant notes, the cited passage of Kayyem teaches the attachment of the passivation layer to the electrode and not characteristics of the passivation layer i.e. insulation. As noted above, the characteristics of the passivation layer are taught (as cited) at Column 23.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:00 TO 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BJ Forman, Ph.D.
Primary Examiner
Art Unit: 1634
March 12, 2004